REMARKS

The present invention is addresses issues involved with options available to a user of a communication terminal such as a cell phone, PDC, and other personal communication devices that are currently available. In this environment, small portable devices with corresponding small operator input controls are provided with limited display screens. Numerous options have been made available to the user as the computing power and memory capabilities have expanded in small sizes. When a user scrolls through the options from a high level hierarchy down to lower level specific functions, numerous entries by the can be required and errors can be encountered by the average layman. Needless to say, a large number of scientists and engineers have attempted to improve user interfaces in these type of devices in view of the ever expanding number of users for such services.

The present invention, as recognized by the allowance of Claims 9-12, provides the ability to limit the necessary entering steps required of a user while logically facilitating displays and functions for the user with a minimal amount of user input.

The Office Action indicated that the subject matter of Claims 1-6 and 13-14 were rendered obvious by a combination of the *Aberg* (WO Publication 00/55717) in view of the *Werkhoven* (WO Publication 99/59097).

In addition, the Office Action indicated that the subject matter of Claims 7 and 8 were completely anticipated by the *Aberg* reference under 35 U.S.C. §102.

The *Werkhoven* reference is directed to an Internet advertising system that attempted to address limitations imposed by browsers and code that would prevent an advertiser from determining if the user had closed a pop-up window of advertisement on his computer before the advertisement completed its presentation.

As can be determined, the *Werkhoven* reference is not for purposes of easing the entry of input signals by a user at his computer, but rather, is intending to impose automatically upon the user when he ventures onto the Internet and selects a particular website, automatic popping up of advertisement windows after the user has begun viewing predetermined information. For example, if the user selects a site on sports and wishes to review the results of his local teams, after a predetermined time period, an advertisement may pop up offering to sell tickets to sports teams. This advertisement will remain for a predetermined time period. Apparently one of the features is if the user exits from that particular page, content of the advertising pop-up can then be reinserted at the back of other windows and again displayed after a third period of time. See, for example, Claim 10 on Page 19 of *Werkhoven* for this disclosure.

Obviously, the *Werkhoven* reference is intended to force the user to be subject to advertisement displays not of his choosing. It is not for the purpose of presenting desired and possibly subjective information to be used by the user from a memory of information that the user has prestored such as e-mail addresses, phone numbers, and individual names.

There is no suggestion of addressing the complexity of small portable devices and their entry keys with the desire to assist the user disclosed in the *Aberg* reference. The Office Action's reliance upon the software code of a computer user interface on the Internet, certainly does not recognize the problems nor offer the solutions of the present invention.

The *Aberg* reference was cited to teach a mobile telephone with a display and a user controlled input device. The hierarchical menu system is stored in a memory and a controller was capable of presenting individual menus and menu items on a display. In essence, the Office Action cited *Aberg* to teach in a cellular radio telephone, a plurality of menus and particularly a

top level menu and a sublevel menu with the controller presenting individual menus or menu items on the display to thereby receive selection commands from the user.

As noted on Page 3 of *Aberg*, the user's entrance into the extended menu system may depend upon the amount of time that the user is holding down a specific menu key. See Page 3, Lines 1-9. The *Aberg* reference purportedly is teaching the concepts of a "dynamic menu, which could be customized by the user." Thus, a user could add and delete menu items on his mobile telephone. In essence, the dynamic menu can present specific menu items that can then be selected by the user and thereby add them to the dynamic menu or remove them from the dynamic menu.

While the *Aberg* reference discloses a hierarchical menu system, it certainly does not teach the features of the present invention. Entering a particular menu or exiting from a particular menu is done by activation of a specific key on the keypad provided on the phone.

> The user may select a particular menu item by pressing a specific key on the keypad 7, such as the YES key 12. The user may exit from any of the top-level or sub-level menus by pressing a particular key, such as the NO key 13. Furthermore, the user may exit the entire menu system by pressing another key, such as the clear key 16.
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> Page 9, lines 30-35.

A person of ordinary skill in this field would gather the following teachings from the *Aberg* reference:

> The essence of the present invention lies in the provision of the SPECIAL to-level menu 300, which is dynamic (the contents may be modified by the user) and is accessible through the normal menu system of the mobile telephone 1. Contrary to the prior art approaches described in previous sections, the provision of the dynamic SPECIAL menu 300 as a to-level menu within the normal menu system will make the mobile telephone easier to use than the prior art telephones. For instance, there is no need for the user to learn the structures of two separate menus, i.e. a short menu and an extended menu, as in aforesaid GB-A-2 293 951.

Page 10, lines 12-22.

In summary, the *Aberg* reference teaches the creation of a dynamic special menu that can be subjectively arranged by a user for his own particular use to avoid learning the contents of two separate menus. It does not teach addressing the problems of multiple hand entries by a user, nor does it set forth time periods that will automatically create various functions and menu displays as provided in our present claims. It is respectfully submitted that there is no suggestion in either *Aberg* nor the *Werkhoven* references that would teach the features of our present invention.

Even, if hypothetically, the prior art *may* be modified in the manner suggested by the Examiner does not make the modification obvious unless the prior art suggested the desirability of the modification. *In re Fritch*, 23 USPQ 2d 1780, 1783-84 (Fed. Cir. 1992).

> [T]he level of skill in the art is a prism or lens through which a judge or jury views the prior art and the claimed invention. This reference point prevents these deciders from using their own insight or, worse yet, hindsight, to gauge obviousness. Rarely, however, will the skill in the art component operate to supply missing knowledge or prior art to reach an obviousness judgment. Skill in the art does not act as a bridge over gaps in substantive presentation of an obviousness case, but instead supplies the primary guarantee of objectivity in the process. *Al-Site Corp. v. VSI International, Inc.*, 50 U.S.P.Q.2d 1161 (Fed. Cir. 1999) (citations omitted).

The Federal Circuit has addressed this issue in the case of *In re Rouffet*, 47 U.S.P.Q.2d 1453, 149 F.3d 1350 (Fed. Cir. 1998). In *Rouffet*, the Court noted that virtually all inventions are combinations of old elements. It concluded that:

> an examiner may often find every element of a claimed invention in the prior art. If identification of each claimed element in the prior art were sufficient to negate patentability, very few patents would ever issue. Furthermore, rejecting patents solely by finding

> prior art corollaries for the claimed elements would permit an examiner to use the claimed invention as a blueprint for piecing together elements in the prior art to defeat the patentability of the claimed invention. Such an approach would be 'an illogical and inappropriate process by which to determine patentability.' *Id.* at 1357.

The Court pointed to the absence of any teaching *in the cited references* for making the proposed modifications, and found that the Board had *reversibly erred* in determining that the invention was rendered obvious because there was no identification of motivation to choose the selected feature.

It is respectfully submitted that the self-serving interest of an advertiser in *Werkhoven* for producing pop-up ads on a computer display, which in many, if not most cases, is an annoyance to the viewer, would not suggest the beneficial advantages of the present invention in eliminating input strokes by a user. The *Aberg* reference attempts to facilitate inputs by a user, not by eliminating input strokes, but by rather having the user initially create a dynamic special menu as a top-level menu within the normal menu system provided in the phone. Thus, numerous strokes are used by the user to customize this dynamic menu and selecting items in the dynamic menu still requires additional keystrokes.

Referring to the *Aberg* reference and our newly drafted Claim 15, there is no teaching or suggestion of measuring "a length of time from when the selected setting item is selected according to the instruction and when the measured length of time exceeds a predetermined length of time, controls such that the display displays a setting value of the selecting setting item." The *Werkhoven* reference is directed to an Internet advertising system and simply discloses a technique for switching an advertisement in accordance with a playlist based on a

predetermined time and displaying the advertisement in a pop-up window, not to the benefit of the user, nor based upon user functions that the user wishes to enjoy in a portable hand device.

Presumably, any hypothetical combination of the teachings of these two diverse references, would have a communication terminal such as a computer-based display, providing a plurality of setting items for related internal functions of the communication terminal, with an operation unit capable of receiving a key input from the user to provide an instruction for selecting a setting item from the plurality of setting items to be displayed. The communication terminal being connected to the Internet, having a pop-up advertisement in accordance with a playlist and based on a predetermined time period be provided on the display and as a variation, if the user inputs a key entry to remove the advertisement that has not completed its play time, it will be re-inserted through a subsequent window to be imposed on the viewer.

There is no structure provided in such a teaching to enable a feature of the present invention specifically controlling "such that the display displays a setting value of the selected setting item."

It is clear that the cited references are not directed to the problems addressed and resolved by the present invention nor would a person of skill in the art combine annoying advertisements with a cell phone menu. In view of the diverse nature of these references, it is respectfully submitted that by focusing on the problems faced by and solved by our present inventors compared with the problems addressed by the cited references, a determination can be made as to whether or not an inadvertent use of hindsight has occurred in assembling references from the template of our present drawings and specification.

In *Orthopedic Co., Inc. v. United States*, 217 USQP 193 (C.A.F.C. 1983), the Federal Circuit set forth a useful guide for determining the scope and content of the prior art. *Orthopedic*, at pages 196-197, also focuses on the "problem" faced by the inventors:

> In determining the relevant art. . . one looks at the nature of the problem confronting the inventor.
>
> * * *
>
> [W]ould it then be nonobvious to this person of ordinary skill in the art to coordinate these elements in the same manner as the claims in suit? The difficulty which attaches to all honest attempts to answer this question can be attributed to the strong temptation to rely on hindsight while undertaking this evaluation. It is wrong to use the patent in suit [the patent application before the Examiner] as a guide through the maze of prior art references, combining the right references in the right way so as to achieve the result of the claims in suit. Monday morning quarterbacking is quite improper when resolving the question of nonobviousness. (Emphasis added)

In view of the above, it is respectfully submitted that our newly drafted claims more than adequately distinguish over the cited references. The claims are more than adequately supported as seen, for example, in Figures 2, 13 and 15 and the respective descriptions in our specification. Thus, Claim 15 displays on a display, a setting value of the selected setting item if the selecting setting item is still in a selective state, in other words a highlighted state, when a predetermined length of time passes from when the setting item is selected from among a plurality of setting items by the user performing a key input.

Therefore, the user can recognize a setting value of the selected setting item without performing an input operation to confirm the selection.

In view of the advantages of the present invention in this relatively crowded field, it is respectfully submitted that the newly drafted claims are also allowed in addition to the previously indicated allowed Claims 9-12.

Patent
82478-4100

An early indication of allowance is respectfully requested.

If the Examiner believes a telephone interview will help further the prosecution of this case, the undersigned attorney can be contacted at the listed phone number.

I hereby certify that this correspondence is being transmitted via facsimile to the USPTO at 571-273-8300 on April 7, 2006.

By: Sharon Farnus

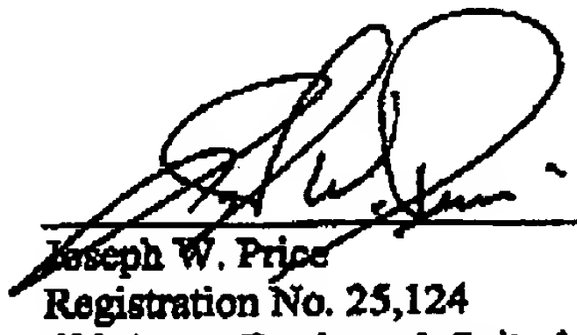
Sharon Farnus

Signature

Dated: April 7, 2006

Very truly yours,

SNELL & WILMER L.L.P.



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